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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/895,493	07/16/1997	MAKOTO SAITO	58800.919C	1079

38834 7590 05/25/2004

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EXAMINER

SEAL, JAMES

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 05/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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2131

48

DATE MAILED: 09/15/2003

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Office Action Summary

Application No.

08/895,493

Applicant(s)

SAITO, MAKOTO

Examiner

James Seal

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 156-181 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 156-181 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 47 + 49 6) ☐ Other:

DETAILED ACTION

1. The request filed on June 11 2003 for a Request for Continued Examination (RCE) under 35 CFR 132 based on parent Application No. 08895493 has been established. An action on the RCE follows.
2. Enclosed IDS has been considered by the examiner and a signed copy is enclosed with this action.
3. Claims 156-181 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 156 – 181 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shear US 4827508 A, and further in view of Smid et. al. 4386233 A.
5. As per claim 156, the limitation of controlling copyrights of digital data is disclosed by Shear. Shear discloses a encrypted digital database (Column 4, lines 68) with a plurality of users (column 7, lines 33-34), in which the user may make request while the system monitors controls (access) to the database (Column 7, line 5-7). That is, the user is permitted controlled access to data (Column 3, lines 62-68), searching (Column 10, line 38), and usage (Column 7, lines 11) of copyrighted materials. Shear is silent on how the cryptographic protection of the database is implemented such as key management. The limitation of supplying the user with a plurality of utilization keys

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that correspond to at different task is taught by Nozawa. Nozawa teaches an information processing system encryption or decryption of data by use of an algorithms *controlled by a desired data key* (Abstract, Column 2, line 25-26, lines 45-48, lines 62-65, Column 4, lines 23—29, Figure 1, Figure 3) for performing such functions as encryption or decryption, with the reading or writing to data from files on a magnetic tape device (Column 5, lines 21-23; lines 42-45 lines 51-56). Thus the cryptographic algorithm is controlled by a desired data key. One of ordinary skill in the art at the time of the invention would have been motivated to combine the operations of access control (permitting the user certain actions) together with utilization keys of Nozawa so that encryption algorithms are transparent (“so that the burden of the upper rank apparatus due to data encryption and decryption can be largely reduced” Column 2, lines 64-65) to the user (host) machine. Claim 156 is rejected.

6. As per claim 157, the limitations of the different types of uses of digital data including display (see Shear Figure 5, element 504, Column 7, line 7), editing (i.e., modifying Column 7, line 11), (copying (Shear Column 7, line 14) and digital data transfer (i.e., telecommunication, Shear Column 7, line 11) and storage (Column 12, lines 44-47). User directed storage of digital data is also disclosed by Nozawa (Nozawa, Column 5, lines 55-56). Claim 157 is rejected.

7. As per claims 158 -159, and 161-163 the limitations of this claims differ from those of claims 156 by recitation that only predefined access tasks can be preformed and in the case of claim 158 those access task are the limiting of the tasks (e.g. transfer, storage, editing, display) to digital data only as defined by copyright control

program. Share discloses the using predefined access task (algorithms) Column 12 lines 1-2. Share further discloses a copyright decoder (decryption) control logic (program) element 316 Figure 3 and Column 16 lines 1-28 for requested use data.

Thus limiting the user to say viewing the documents (browsing) or the number of times the document can be viewed or the number of requests or tasks (use of usage keys) that the system can perform, or the type of data the user could access (digital versus analog or video or music etc.) would constitute limiting through predefined access by the copyright decoder control logic. Claims 158 -159 and 161-163 are rejected.

8. As per claim 160, the limitation of displaying a copyright control message attempts to use other than predefined commands is taught by Shear. Shear teaches the issuance of warning messages if the user contravenes security policies (i.e. no tampering with the system, Column 21 line 59). Claim 160 is rejected.

9. As per claim 164, the limitation that the copyright information includes authorship information (author or authors; that is history of the document) for the purpose of copyright royalties is disclosed by Shear (Column 6; lines 49-54). Claim 164 is rejected.

10. As per claim 165, the limitations of claims 159-163 have been addressed above. The further limitation that the copyright control program supplies the user with at least one of the plurality of utilization keys is disclosed by Shear (Column 14, lines 3-16). Shear teaches the use of the copyright control program (decoder control logic) in its role in decrypting the database and Nozawa teaches the generation of function (usage) keys by the data key cryptographic device to the user (host) element 1 Figure 1, which in turn uses time to decrypt the data to operate or manipulate it. Claim 165 is rejected.

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11. As per claim 166, the limitations of claims 159-163 have already been addressed above. The additional limitation of data limited to digital data has been addressed in ¶7.

Claim 166 is rejected.

12. As per claim 167, the limitation of a key control center Shear is silent. Nozawa discloses such a center in Figure 1, element 11. Claim 167 is rejected.

13. As per claim 168, the limitation of supplying a copyright control program from the key control center to the user with at least one permit key One of ordinary skill in the art at the time the invention was made would have been motivated to Shear combine the function of encrypted copyright control system with Nozawa's key control center in order and the association of desired data keys with to make the "burden" of encryption/decryption transparent to the user of the system. Claim 168 rejected.

14. The limitations of claim 169, are identical to those of claims 156, with the added limitations that the uses specified in claim 156 are now specified (display edit copy storage and transfer) which have been addressed in claim 157. Claim 169 is rejected.

15. As per claims 170-172, the limitations of limiting the functions to display or edit and limiting their use to digital data are disclosed in Column 7, lines 5-14, Column 12, lines 1-2. claims 170-172 rejected.

16. As per claim 173, the limitation of a warning message is disclosed in Shear (Column 21, line 59). Claim 173 is rejected.

17. As per claims 174-5, the limitation of limiting the number of times digital data used see Shear claim 1 last part. Note in accordance with the teaches of Nozawa and

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Shear, limiting the number of times a function key were used would also be included.

Claims 174-175 are rejected.

18. As per claims 176-177, the limitation of maintaining copyright and history information on authorship is disclosed by Shear see Column 4, lines 10-40. Claims 176-177 rejected.

19. As per claim 178, the limitations of claims 172-176 have been discussed above, and the further limitation of supplying the copyright control program to the user with at least one key Nozawa Figure 1, element 11. Claim 178 is rejected.

20. As per claim 179, the limitations of claims 172-176 have been discussed above, the further limitation with supplying the copyright control program to the user with the encrypted digital data see Nozawa Figure 1, element 11 and Column 2, lines 60-67. Claim 179 rejected.

21. Claim 180 is rejected under 35 U.S.C. 103(a) as being unpatentable over Atalla 4588991 A, and further in view of Nozawa .

22. As per claims 180-181, wherein the database includes a key control center for maintaining of a plurality of utilization permit keys. Atalla discloses a data distribution over a network (see Figure 3). Atalla further provides that the key control center and software are with the database (see figure 3). Norawa discloses function dependent encryption keys. Thus one of ordinary skill in the art would have been motivated at the time the invention was made to have included the key control center with the database if the distribution is to be done by network. Claims 180-181 is rejected.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Seal whose telephone number is 703 308 4562. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703 305 9658. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 3900.



James Seal
Examiner AU 2131

8 Sept 2003